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Docket 78685F-P
Customer No. 01333AF
300

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:
John R. Fredlund, et al

Group Art Unit: 3722

SYSTEM FOR DISPLAYING,
STORING AND RETRIEVING IMAGES

Examiner: Willmon Fridie, Jr.

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Serial No. 09/213,169

Paula West
Paula West

Filed 30 November 2000

3-22-04
DateCommissioner for Patents
P.O. Box 1450
Alexandria, VA. 22313-1450

Transmitted herewith is Applicants Reply Brief in the above-identified application:

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(For Extensions of Time and other Petitions to the Assistant Commissioner)

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TECHNOLOGY CENTER R3700



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Customer No. 01333

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In re Application of:

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REPLY BRIEF

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Grouping of claims:

The Examiner's argument that the Appeal Brief does not contain a statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeals is contained in a brief, and therefore it is presumed that there are none. Applicant believes that an appropriate statement has been provided with regard to related appeals and interferences. For the record, Applicant is not aware of any appeals and interferences directly related to the pending application.

With regard to the claims, the Examiner is correct in that claim 3 should have been provided with the claims of Group II as claim 3 depends upon claim 2.

With regard to groups III, IV and V, these groups are all directed to a system for displaying, storing and retrieving images all of which include the limitation of a silhouette of the plurality of images provided on said first image retaining section of said first side and thus were believed to be sufficiently related

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Paula West
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3-22-04
Date

with respect to patentability as they were all grouped in a single grouping and therefore were argued together. However, Applicant agrees to the grouping as suggested by the Examiner.

Response to Examiner's Arguments:

The Examiner argues that item 60a, 61a of Shiota define a silhouette. In this regard the items the Examiner refers to are actually thumbnail images of the images that are on the film. In this regard, Applicant would like to point out that the plain definition of silhouette is directed to "a drawing consisting of the outline of something esp. a human profile, filled with a solid color" or "an outline of an object that appears dark against a light background". See Appendix A attached hereto which is the definition of silhouette found in Webster's II New College Dictionary. See also Appendix B definition of silhouette in Webster's Ninth New Collegiate dictionary which states: "a likeness cut from dark material and mounted on a light ground or one sketched in outline and solidly colored in". This is in contrast to items 60a and 61a of Shiota which is simply a small image of other larger images already present, and thus is not a silhouette as taught and claimed by Applicant. Further, the frame numbers referred to in Applicant's response do not identify the source of the images as taught and claimed by Applicant. They merely identify the location or sequence of the image on the film that captured the image, not the source of the image. Every film has sequence numbers for the frames, thus the frame number could not identify the source from which the image originated as claimed by Applicant.

The Examiner further argues that it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide Manico et al. with identifying icon with identification numbers which correspond to the images on the album as taught by Shiota in order to categorize the content or provide more information of the images. In this regard, Applicant respectfully submits that there is no teaching, suggestion or motivation to make the combination as suggested by the Examiner. As the CAFC said in *In re Lee* 277 Fed 3rd 1338 (61 USPQ 2nd 1430) 2002

"When patentability turns on the question of obviousness, the search for and analysis of the prior art includes evidence relevant to the finding of whether there is a teaching, motivation, or suggestion to select and combine the references relied on as evidence of obviousness."

The Court further stated:

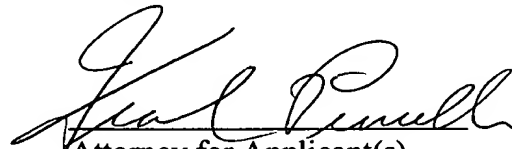
“our case law makes clear that the best defense against the subtle but powerful attraction of hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art teachings of references can be combined only if there is some suggestion incentive to do so.” See *In re Lee* at 1433.

“the Examiner can satisfy the burden of showing obviousness of the combination only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead the individual to combine the relevant teachings of the references.” (see *In re Lee* at 1434).

In the present instance, the Manico reference is directed to an album leaf while the Shiota reference is directed to a photographic printer for printing images on photographic paper. The photographic paper is simply the output of a printer of Shiota in contrast to the album leaf illustrated in Manico. There is no teaching or suggestion of combining one with the other, nor is there any reason or motivation to do so. In addition, as Applicants have previously discussed, there is no teaching or suggestion of providing an icon identifying the source from which images originated as taught and claimed by Applicant, nor does the cited art teach or suggest the silhouette of the images provided on the album leaf as taught and claimed by Applicant.

For the foregoing reasons and reasons previously discussed, Applicant respectfully submit that the claims in their present form are in condition for allowance and such action is respectfully requested.

Respectfully submitted,

A handwritten signature in dark ink, appearing to read 'Frank Pincelli', written over a horizontal line.

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Riverside 

Webster's II

New College Dictionary

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Abbreviations

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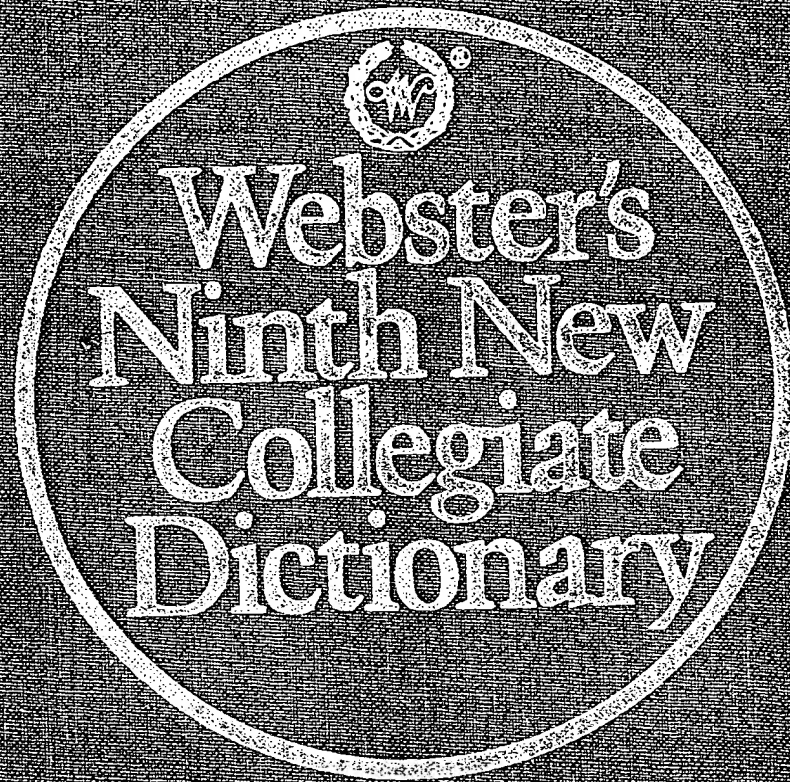
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rō abuse zh vision a about item edible gallop, cir



roô abuse zh vision ə about, item, edible, gallop, circ

silicic acid *n.* A jellylike substance; $\text{SiO}_2 \cdot n\text{H}_2\text{O}$.
silicic acid solution *n.* A solution of silicic acid in water.
sodium silicate solution *n.* A solution of sodium silicate in water.
sodium silicate solution *n.* A solution of sodium silicate in water.

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